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63649 7590 11/09/2009 DISNEY ENTERPRISES C/O FARJAMI & FARJAMI LLP 26522 LA ALAMEDA AVENUE, SUITE 360 MISSION VIEJO, CA 92691				
EXAMINER CHAMPAGNE, DONALD				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* ERIC C. HASELTINE,
9 PAUL H. DIETZ,
10 SHELLY O. SHORT,
11 and AMY VAN GILDER
12

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14 Appeal 2009-004082
15 Application 09/898,164
16 Technology Center 3600
17

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19 Decided: November 9, 2009
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22 Before ANTON W. FETTING, JOSEPH A. FISCHETTI, and BIBHU R.
23 MOHANTY, *Administrative Patent Judges*.
24 FETTING, *Administrative Patent Judge*.

25 DECISION ON APPEAL
26

1 STATEMENT OF THE CASE

2 Eric C. Haseltine, Paul H. Dietz, Shelly O. Short, and Amy Van Gilder
3 (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of
4 claims 1-2, 4, 8, 10-13, 38-45, 58, 61, 65, and 68, the only claims pending in
5 the application on appeal.

6 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
7 (2002).

8 SUMMARY OF DECISION¹

9 We AFFIRM.

10 THE INVENTION

11 The Appellants invented a method for distributing electronic tokens in a
12 broadcast for the enhancement and improvement of advertising methods
13 (Specification ¶ 0002).

14 An understanding of the invention can be derived from a reading of
15 exemplary claims 1 and 10, which are reproduced below [bracketed matter
16 and some paragraphing added].

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed March 28, 2008) and Reply Brief ("Reply Br.," filed July 22, 2008), and the Examiner's Answer ("Ans.," mailed June 25, 2008), and Final Rejection ("Final Rej.," mailed November 5, 2007).

1 1. A method for providing incentive to a user to receive
2 information, the method comprising:

3 [1] providing a programming broadcast signal to a broadcast
4 receiving appliance;

5 [2] providing a token embedded in an audio signal of the
6 programming broadcast signal;

7 [3] receiving, by the broadcast receiving appliance, the token
8 embedded in the audio signal of the programming broadcast
9 signal;

10 [4] emitting, by the broadcast receiving appliance, the audio
11 signal including the token from the broadcast receiving
12 appliance, wherein the token is emitted outside of a normal
13 hearing frequency range of an acoustic spectrum of the audio
14 signal;

15 [5] providing a token capture device configured to receive
16 the token during the emitting of the programming; and

17 [6] providing an incentive for using the token capture device
18 to receive the token.

19
20 10. The method according to claim 1, wherein the incentive
21 comprises providing a reward in exchange for redemption of a
22 token capture device having indication thereon of a received
23 token signal.
24

25 THE REJECTIONS

26 The Examiner relies upon the following prior art:
27

Mankovitz et al.	5,523,794	Jun. 4, 1996
Lappington et al.	5,638,113	Jun. 10, 1997
Brusky et al.	5,903,259	May 11, 1999

Claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lappington and Brusky.

Claims 10, 12, 13, 39, and 40 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz.

ISSUES

The issues pertinent to this appeal are whether the Appellants have sustained the burden of showing that the Examiner erred in rejecting claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 under 35 U.S.C. § 103(a) as unpatentable over Lappington and Brusky and in rejecting claims 10, 12, 13, 39, and 40 under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz. These pertinent issues turn on whether Lappington describes embedding a token in the audio portion of a broadcast signal and whether the Brusky description of the term inaudible refers to a signal that is outside of a normal hearing frequency range.

FACTS PERTINENT TO THE ISSUES

The following enumerated Findings of Fact (FF) are believed to be supported by a preponderance of the evidence.

Facts Related to Appellants' Disclosure

01. Tokens are akin to coupons, and represent a right, authority, or identity (Specification ¶ 0014).

Facts Related to the Prior Art

Mankovitz

02. Mankovitz is directed to a method and apparatus for decoding data included in the vertical blanking interval of a television transmission signal and a portable data coupon for storage of selected information from the data received by the system for future use (Mankovitz 1:10-14).

Lappington

03. Lappington is directed to a system that allows users to interact with the system to shop, enter into games of skill, engage in educational presentations, and other interactive events (Lappington 1:27-35).

04. Lappington describes a transaction based interactive television system where interactions between the system and viewer occur over a period of time (Lappington 5:5-9). Each of the interactions can be broken down into and defined by a plurality of transactions (Lappington 5:5-9). Each transaction is numbered so that the first transaction in a segment is assigned a transaction number of one (Lappington 10:32-34).

05. The interactive system includes a set of transactions defined as interactive data, such as questions or informational statements, to be sent to a viewer during a television broadcast (Lappington 8:10-13). These questions or statements are inserted by the data insertion control, utilizing an insertion card, into the vertical blanking interval (VBI) of an incoming television signal (Lappington 8:21-25). Alternatively, interactive data can be

transmitted using the audio portion of a television signal,
luminance, digital packets, radio communications, or other
appropriate mediums.

06. An insertion card encodes the interactive data to the television
signal and sends the encoded television signal to a transmitter,
which transmits the signal to home viewers (Lappington 8:46-48
and 8:58-67).

Brusky

07. Brusky is directed to a wireless computer keyboard device
which incorporates the functionality of a wireless remote (Brusky
1:8-10).

08. Brusky describes a wireless keyboard that communicates with a
computer using the wireless transmissions of IR or RF (Brusky
2:45-48). Brusky describes that the means of transmission
contemplated include an infrared, radio frequency,
electromagnetic signals, and sound waves (including audible and
inaudible sounds) (Brusky 7:65-67 and 8:1-4).

Facts Related To The Level Of Skill In The Art

09. Neither the Examiner nor the Appellants have addressed the
level of ordinary skill in the pertinent arts data mining and
advertising. We will therefore consider the cited prior art as
representative of the level of ordinary skill in the art. *See Okajima*
v. Bourdeau, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he
absence of specific findings on the level of skill in the art does not
give rise to reversible error ‘where the prior art itself reflects an

appropriate level and a need for testimony is not shown”)
(quoting *Litton Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755
F.2d 158, 163 (Fed. Cir. 1985).

Facts Related To Secondary Considerations

10. There is no evidence on record of secondary considerations of
non-obviousness for our consideration.

PRINCIPLES OF LAW

Obviousness

A claimed invention is unpatentable if the differences between it and
the prior art are “such that the subject matter as a whole would have been
obvious at the time the invention was made to a person having ordinary skill
in the art.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007); *Graham*
v. John Deere Co., 383 U.S. 1, 13-14 (1966).

In *Graham*, the Court held that that the obviousness analysis is
bottomed on several basic factual inquiries: “[(1)] the scope and content of
the prior art are to be determined; [(2)] differences between the prior art and
the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
in the pertinent art resolved.” *Graham*, 383 U.S. at 17. *See also KSR*, 550
U.S. at 406. “The combination of familiar elements according to known
methods is likely to be obvious when it does no more than yield predictable
results.” *Id.* at 416.

ANALYSIS

*Claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 rejected under 35
U.S.C. § 103(a) as unpatentable over Lappington and Brusky*

The Appellants first contend that (1) Lappington fails to describe that the audio signal includes the token (App. Br. 7). The Appellants specifically argue that a radio communication described by Lappington is not the same as an audio emission (App. Br. 8). We disagree with the Appellants. Limitation [2] requires embedding a token into an audio signal of the programming broadcast. The Specification describes a token to represent a right, authority, or identity (FF 01). Lappington describes embedding interactive data or transactions into the audio signal of a television signal, luminance, digital packets, radio communications, or other appropriate mediums (FF 05). Each of the transactions includes an identification number (FF 04) and is therefore the same as a token because it represents an identity. As such, Lappington describes embedding a transaction or token into the audio portion of a television signal, as required by claim 1. Although Lappington does describe a radio communication, Lappington also describes embedding a transaction in the audio portion of a broadcast signal and therefore the Appellants' specific argument that a radio communication is not an audio emission is not persuasive.

The Appellants further contend that (2) Lappington fails to describe that the programming broadcast signal, which is provided to the broadcast receiving appliance, includes a token embedded in an audio signal of the programming broadcast signal (App. Br. 8-11). The Appellants specifically contends that the claimed invention does not require extracting the token

1 from the broadcast signal and encoding a transmission signal for
2 transmitting the token to a user device (App. Br. 10). We disagree with the
3 Appellants. As discussed *supra*, Lappington describes embedding a
4 transaction or token into the audio portion of a television signal. Lappington
5 also describes that the encoded television signal is transmitted by a
6 transmitter to the home viewers' devices (FF 06). As such, Lappington
7 describes these limitations of claim 1. The Appellants' specifically argue
8 that when utilizing the claimed invention, "the broadcast receiving appliance
9 avoids extracting the token from the broadcast signal and avoids encoding a
10 transmission signal for transmitting the token to a user device, as the audio
11 signal that is received broadcast receiving appliance includes the token"
12 (App. Br. 10). However, this language is not recited in claim 1 and we find
13 no basis for reading this language into claim 1. As such, this argument is not
14 found to be persuasive.

15 The Appellants also contend that (3) Brusky fails to describe the token is
16 emitted outside of a normal hearing frequency range of an acoustic spectrum
17 of the audio signal (App. Br. 11). The Appellants specifically argue that
18 emissions outside of a normal hearing frequency range of an acoustic
19 spectrum are not considered a sound to a human ear, and inaudible refers to
20 the volume sound within the audible range (App. Br. 11). We disagree with
21 the Appellants. Brusky explicitly describes a transmission using sound
22 waves that can be either audible or inaudible (FF 08). The plain meaning of
23 an inaudible sound wave is a sound wave that is incapable of being heard.
24 One of ordinary skill in the art would have understood in the context of
25 using transmissions to command an electronic device as described by
26 Brusky, an inaudible sound wave is a signal with a frequency outside of the

range that a human ear can detect. As such, the Appellants' argument that inaudible refers merely to a low volume is not found persuasive because it is not consistent with the context of Brusky's disclosure.

The Appellants' contention that Brusky fails to describe the emission of a token does not persuade us of error on the part of the Examiner because the Appellants respond to the rejection by attacking the references separately, even though the rejection is based on the combined teachings of the references. The Examiner has relied on Lappington to describe the emission of a token as discussed *supra*. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 under 35 U.S.C. § 103(a) as unpatentable over Lappington and Brusky.

Claims 10, 12, 13, 39, and 40 rejected under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz

The Appellants contend that dependant claims 10, 12, 13, 39, and 40 are allowable for the same reasons argued *supra* in support of independent claims 1 and 38. The Appellants' arguments were not found persuasive *supra* and therefore are not found persuasive here for the same reasons. As such, the Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 10, 12, 13, 39, and 40 under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz.

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CONCLUSIONS OF LAW

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The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 under 35 U.S.C. § 103(a) as unpatentable over Lappington and Brusky.

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The Appellants have not sustained the burden of showing that the Examiner erred in rejecting claims 10, 12, 13, 39, and 40 under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz.

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DECISION

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To summarize, our decision is as follows.

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- The rejection of claims 1, 2, 4, 8, 11, 38, 41-45, 58, 61, 65, and 68 under 35 U.S.C. § 103(a) as unpatentable over Lappington and Brusky is sustained.

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- The rejection of claims 10, 12, 13, 39, and 40 under 35 U.S.C. § 103(a) as unpatentable over Lappington, Brusky, and Mankovitz is sustained.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2007).

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AFFIRMED

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5 mev

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